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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,224	11/21/2003	Janet K. O'Grady	T-733	3177
27199	7590	05/23/2006	EXAMINER	
THE PROCTOR & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL TECHNICAL CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATTI, OH 45224			ARNOLD, ERNST V	
			ART UNIT	PAPER NUMBER
			1616	
DATE MAILED: 05/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/719,224	O'GRADY ET AL.
	Examiner Ernst V. Arnold	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
  - 4a) Of the above claim(s) 11-21 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/25/04; 8/15/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____ .

## **DETAILED ACTION**

The Examiner acknowledges receipt of application number 10/719,224 filed on 11/21/2003. Claims 1-21 are pending.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I.     Claims 1-10, drawn to a topical cosmetic composition for providing noticeably healthy looking human skin comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B<sub>3</sub> and vitamin C, wherein said vitamin A, said vitamin E, said aloe, and said at least one member are each independently included in an amount of about 0.001% to about 5% by weight of the composition, classified in class 514, subclass 356, 458, 474 and 725, for example.
- II.    Claims 11-21, drawn to a method of providing noticeably healthy looking human skin which comprises applying to human skin at least once a day over at least seven days a topical cosmetic composition comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B<sub>3</sub> and vitamin C, wherein said vitamin A, said vitamin E, said aloe, and said at least one member are each independently included in an amount of about 0.001% to about 5% by weight of the

composition, classified in class 424, subclass 78.03, 401 and 744, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the method of providing noticeably healthy looking human skin as claimed can be practiced with Johnson's Baby Lotion. The composition as claimed can be used as a food additive to provide vitamins to undernourished individuals.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification and would present an undue burden of search on the Examiner, restriction for examination purposes as indicated is proper.

During a telephone conversation with Stephan Williams on 05/16/06 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, and 7-10 are rejected under 35 U.S.C. 102(a) and 35 U.S.C. 102(e) as being anticipated by Jensen et al. (US 2002/0192246 A1 (published: Dec. 19, 2002)).

Jensen et al. disclose a topical skin care composition formulated as a lotion, cream or a gel which contains vitamin C, vitamin E, aloe vera, bisabolol, vitamin A in amount of about 0-1 % by weight and panthenol in an amount between about 1-5 % by weight (Page 6, [0076]; claims 1, 48, 56 and 58). The Examiner notes that the Noni plant contains niacin but the exact amount is not disclosed (Page 3, [0043]).

With respect to the art rejection above, it is noted that the reference does not teach that the composition can be used in the manner instantly claimed, shaving gel, however, the intended use of the claimed composition does not patentably distinguish the composition, *per se*, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsieh (WO 98/30198).

Hsieh discloses hand and body lotion and cream compositions which contain 0.38 % vitamin A palmitate, 0.75 % magnesium ascorbyl phosphate (Vitamin C derivative), 0.38 % vitamin E acetate, 0.38 % alpha-bisabolol, 0.25 % panthenol and 1.00 % aloe vera gel concentrate thus anticipating instant claims 1, 2, 4, and 7-10 (Page 7, example 1, lines 15-42 and see also examples 2 and 3 on page 8).

With respect to the art rejection above, it is noted that the reference does not teach that the composition can be used in the manner instantly claimed, shaving gel, however, the intended use of the claimed composition does not patentably distinguish the composition, *per se*, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

#### ***Claim Rejections - 35 USC § 102***

Claims 1, 2, 4 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Mausner (US 5,571,503).

Mausner discloses a moisture lotion composition that contains 0.01-2.0 % tocopheryl acetate, 0.01-2.0 % retinyl palmitate, 0.01-2.0 % ascorbyl palmitate, 0.01-2.0 % panthenol, 0.01-2.0 % aloe extract thus reading on instant claims 1, 2, 4, 7, 9 and 10 (Column 15, Table 1). The Examiner notes that matricaria extract is present from 0.01-

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2.0 % by weight and is derived from wild chamomile (Column 10, lines 31-41 and column 15, line 16).

With respect to the art rejection above, it is noted that the reference does not teach that the composition can be used in the manner instantly claimed, shaving gel, however, the intended use of the claimed composition does not patentably distinguish the composition, *per se*, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh (WO 98/30198) in view of Fike (US 5,612,382).

Applicant claims a topical cosmetic composition for providing noticeably healthy looking human skin comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B<sub>3</sub> and vitamin C, wherein said vitamin A, said vitamin E, said aloe, and said at least one member are each independently included in an amount of about 0.001% to about 5% by weight of the composition.

**Determination of the scope and content of the prior art**

**(MPEP 2141.01)**

The reference of Hsieh is discussed in detail above and that discussion is hereby incorporated by reference.

Fike teaches the addition of 0.1 to 15 weight percent of vitamin B<sub>3</sub> (niacin) or derivatives thereof to compositions for delivering active ingredients through the skin or mucosal tissues (Abstract; column 4, lines 46-67 and claims 1, 6 and 7, for example).

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Hsieh does not expressly teach the addition of vitamin B<sub>3</sub> in an amount of about 0.001 % to about 5 % by weight of the composition.

**Finding of *prima facie* obviousness**

**Rational and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add vitamin B<sub>3</sub> in an amount from 0.1 to 15 % by weight, as suggested by Fike, to the composition of Hsieh and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Fike teaches that compositions containing niacin may also be used to soften, moisturize and reduce the flakiness of the skin (Column 4, lines 45-49). One of ordinary skill in the art would want these desirable characteristics of any skin lotion, cream, cleansing composition or gel and would therefore be motivated to add niacin to the skin care product.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (6:15 am-3:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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